

Application Serial No. 10/791,187

Attorney Docket No.: 076838-138901/US

REMARKS

Applicant submitted an affidavit, dated December 18, 2008, under 37 CFR 1.131 to swear behind U.S. Patent No. 6,239,765 ("Johnson").

Johnson was filed on August 24, 1999. Although Johnson claims priority to the provisional Application Serial No. 60/121,989, this provisional application does not disclose the subject matter relied upon in the rejections of the claims of the present application.

Although Fig. 6c of the provisional Application Serial No. 60/121,989 shows a hand written note: "dual band operation also *possible* by the design of the copper traces (800-900 & 1850-1990 MHz for instance)" (emphasis added), the description of Fig. 6 on page 5 of the provisional application does not teach *how* to design the copper traces to enable dual band operations. Thus, this handwritten note in Fig. 6c of the provisional Application Serial No. 60/121,989 is not an enabling disclosure for dual band operations.

According to MPEP, a 102(e) reference is entitled to the filing date of a provisional application only if the provisional application has enabling support, in compliance with 35 U.S.C. 112, first paragraph.

"The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph." (MPEP 2136.03 III)

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth

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the best mode contemplated by the inventor of carrying out his invention.” (35 U.S.C. 112, first paragraph)

Since the provisional Application Serial No. 60/121,989 does not have an enabling description, in compliance with 35 U.S.C. 112, first paragraph, regarding the “dual band operation”, Johnson’s description is not entitled to the filing date of the provisional Application Serial No. 60/121,989.

Further, a suggestion for “dual band operation” is not necessarily a suggestion for a “dual band antenna”.

The provisional Application Serial No. 60/121,989 neither disclose the design of the tri-band antenna shown in Fig. 9 of Johnson, nor disclose a method that could lead to the design of multi-band antenna. Thus, the provisional Application Serial No. 60/121,989 does not provide sufficient support for the portion of the disclosure of Johnson which was relied upon for the rejections.

Thus, the portion of the disclosure of Johnson which was relied upon for the rejections does not entitle to the earlier filing date of the provisional Application Serial No. 60/121,989. Thus, the priority date of the portion of the disclosure of Johnson which was relied upon for the rejections is August 24, 1999.

The affidavit submitted on December 18, 2008 established that the parent application of the present application was ready for filing at least on August 11, 1999. Applicant’s representative worked diligently to obtain inventor signatures, by sending the requests for inventor signatures on August 11, 1999 and again on August 24, 1999. Failing to obtain the inventor signatures in a short time, Applicant’s representative filed the parent application of the present application on September 2, 1999, without inventor signatures.

Thus, the invention as described in the parent application of the present application was conceived at least before August 11, 1999, which is before August 24, 1999, the filing date of Johnson; and the Applicant’s representative worked diligently to file the application.

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Therefore, Johnson is not a prior art under 35 U.S.C. 102(e). The withdrawal of the rejections based on Johnson is respectfully requested.

Furthermore, Applicant submits the attached affidavit under 37 CFR 1.131 to swear behind the provisional Application Serial No. 60/121,989.

Respectfully submitted,

Date: _____

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